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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/992,232	11/06/2001	Carl C. Awh	54084-8682	5474
21888	7590	10/01/2004	EXAMINER	
THOMPSON COBURN, LLP			THALER, MICHAEL H	
ONE US BANK PLAZA			ART UNIT	
SUITE 3500			PAPER NUMBER	
ST LOUIS, MO 63101			3731	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,232

Applicant(s)

AWH ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 2 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear what the structure of the alternative embodiment described on page 8, lines 22-24 is and how one would construct it. In the embodiment shown in figures 3-7, finger pad 26 is secured to the exterior of sleeve 20 while the optic fiber is inside of sleeve 20. In the alternative embodiment described on page 8, lines 22-24, it is unclear how finger pad 26 could reach the optic fiber to be attached to it since sleeve 20 is between finger pad 26 and sleeve 20 and thus would interfere with such attachment.

Claims 1-4 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb (2002/0193781) in view of Colgan et al. (6,648,902). Loeb discloses handle 14, tubular sleeve 2 and optical fiber 6 having an adjustable bend therein (since it is fixed within cannula 4 which has a preformed bend). Loeb fails to disclose that the optical fiber 6 is plastic. However, it is old and well known in this art to use plastic as the material for optical fibers since it is durable, flexible and relatively inexpensive. For example, Colgan et al. teaches that

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polymethylmethacrylate plastic should be used as the material for an optical fiber used in a surgical instrument for these reasons (col. 6, lines 18-25 and col. 10, lines 1-11). It would have been obvious to use plastic as the material for the Loeb optical fiber 6 so that it too would have these advantages. As to claim 4, the distal end portion of optical fiber 6 has a preformed bend since it is fixed within cannula 4 which has a preformed bend. As to claim 7, Loeb fails to disclose an interior bore in optical fiber 6. However, it is old and well known in this art to include a bore in optical fibers since it is permits fluid to be inserted or removed from the body therethrough. It would have been obvious to include a bore in the Loeb optical fiber 6 so that it too would have this advantage. The above well known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertions (M.P.E.P. 2144.03). As to claim 13, Loeb discloses a layer of sliding material 64.

Claims 5, 6, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb (2002/0193781) in view of Colgan et al. (6,648,902) as applied to claim 1 above, and further in view of Esch et al. (5,469,524). Loeb fails to disclose the handle 14 having a mechanism connected to the sleeve 2 to move it. However, Esch et al. teach that a handle

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37 should have a mechanism 41 connected to a sleeve 45 which surrounds an optic fiber 53 in order to retract or extend the sleeve relative to the optic fiber apparently so that sleeve 45 may be conveniently retracted or extended (col. 2, line 53 to col. 3, line 15). It would have been obvious to include such a mechanism on the Loeb handle so that it too would have this advantage.

Claims 15, 16, 18 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esch et al. (5,469,524) in view of Colgan et al. (6,648,902). Esch et al. disclose handle 37, tubular sleeve 45, optical fiber 53 and mechanism 41. Esch et al. fail to disclose that the optical fiber 53 is plastic. However, it is old and well known in this art to use plastic as the material for optical fibers since it is durable, flexible and relatively inexpensive. For example, Colgan et al. teaches that polymethylmethacrylate plastic should be used as the material for an optical fiber used in a surgical instrument for these reasons (col. 6, lines 18-25 and col. 10, lines 1-11). It would have been obvious to use plastic as the material for the Esch et al. optical fiber 53 so that it too would have these advantages.

Applicant's arguments filed June 1, 2004 have been fully considered but they are not persuasive. As to the rejection of

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claims 2 and 4 under 35 U.S.C. 112, first paragraph, the embodiment described on page 8, lines 22-24 differs from the embodiment shown in figures 3-7 in that the moving part is the optic fiber rather than sleeve 20. In the embodiment shown in figures 3-7, it is clear how finger pad is connected to the movable sleeve 20. However, in the alternative embodiment described on page 8, lines 22-24, it is unclear how finger pad 26 could reach the optic fiber to be attached to it since sleeve 20 is between finger pad 26 and sleeve 20 and thus would interfere with such attachment. The rejection of claims 17 and 19-21 (in the first Office Action) under 35 U.S.C. 103(a) as being unpatentable over Loeb (2002/0193781) in view of Esch et al. (5,469,524) was clear. As set forth in the rejection of claims 17 and 19-21, Loeb was the primary reference and Esch et al. is the secondary reference. Although claim 15 was not rejected using Loeb as the primary reference, claim 17, which includes all the limitations of claim 15 (as well as claim 16) was rejected using Loeb as the primary reference. Claim 15 was rejected based on Esch et al. Optical fiber 6 of Loeb has an adjustable bend therein, as broadly claimed, since it is fixed within cannula 4 which has a preformed bend. Although the adjustable bend of fiber 6 is preformed by the surrounding

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cannula 4 attached thereto, the claims do not preclude this arrangement.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (703)308-2154. The fax phone number for the

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organization where this application or proceeding is assigned is
(703)872-9306.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is (703)308-0858.

mht
9/27/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731